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REMARKS

Applicant respectfully requests entry of the foregoing amendments and reconsideration of the application in view of the amendments above and the remarks below. Claims 1-17, and 19 have been amended, and claims 1-20 remain pending in the application. Claims 1, 10, and 16 are independent claims.

Rejections Under 35 U.S.C. § 101

Claims 1-15 stand rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. Applicant respectfully traverses this rejection and submits that this rejection has been rendered moot by the foregoing amendments.

Specifically, regarding independent claims 1 and 10, the Examiner asserts that these claims are not directed to statutory subject matter because they do not “recite any computer technology or physical means.” (Office Action at 3-4.) The Examiner summarily states that all claims that depend from these claims are also considered to be directed to non-statutory subject matter.

Applicant respectfully objects to the Examiner’s sweeping rejection of claims 2-9 and 11-15 without individual analysis, and respectfully submits that at least some of these claims met the Examiner’s stated test for reciting statutory subject matter prior to the above amendments. For example, both claims 9 and 15 recite (and recited prior to the above amendments) a “transaction record being in at least one of an electronic form and a digital form,” which would require handling by “computer technology or [other] physical means,” as apparently is being required by the Examiner.

Additionally, although Applicant does not acquiesce to the Examiner’s characterization of claims 1 and 10, the rejection of these claims has been rendered moot by the foregoing amendments. For example claims 1 and 10, as amended, both recite “[a] processor-readable medium storing code representing instructions to cause a processor to perform a process,” which is certainly “computer technology.”

Claims 1-10 and 12-20 are patentable under 35 U.S.C. § 103

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,024 to Shkedy (hereinafter "*Shkedy*") in view of U.S. Patent No. 6,070,145 to Pinsley et al. (hereinafter "*Pinsley*"). Applicant respectfully traverses this rejection for the reasons set forth below.

Independent claim 1 recites a processor-readable medium comprising code representing instructions to cause a processor to perform a process. The instructions include code to receive transaction information related to a transaction, which includes consumer information and merchant information. The instructions also, among other features, cause a processor to determine whether to invite the consumer to complete a survey related to the transaction "***based at least partially on at least one of the consumer information and the merchant information.***"

Independent claim 10 recites a processor-readable medium storing code representing instructions to cause a processor to perform a process, which includes, among other features, "instructions to cause a processor to ... determine, ***using the historical consumer information,*** whether to collect survey information from the consumer in the transaction."

Independent claim 16 recites a system for collecting survey information relative to a transaction. The system includes a monitoring interface, a processor, and a participant interface. The processor is configured to analyze said transaction record relative to stored consumer information, and is "further configured to determine whether to solicit survey information from the consumer to the transaction ***based at least partially on the transaction record.***"

Shkedy is directed to a method and apparatus for facilitating buyer-driven purchase orders on a commercial network system. According to *Shkedy*, offers from multiple, individual buyers can be aggregated or pooled into a single, collective offer. Some embodiments of *Shkedy* utilize a computer acting as an intermediary to facilitate a transaction between a plurality of buyers and at least one seller. Any information collected by the system of *Shkedy* from prospective purchasers is done prior to a transaction (e.g., a purchase). Also, one object of *Shkedy* is to protect the anonymity of parties to transactions by shielding buyer and seller information from marketing personnel.

Pinsley is directed to a respondent selection method for network-based surveys. *Pinsley* describes conducting a survey of users of an information document site located on a computer

network. The method of *Pinsley* invokes a survey program to launch a survey when a user accesses information content via a network. Whether or not an offer to participate in a survey is made is based on random or statistically driven pseudo-random criteria.

Claim 1 is not obvious in view of *Shkedy* and *Pinsley*

The combination of *Shkedy* and *Pinsley* fails to disclose or suggest each feature of independent claim 1. For example, the Examiner admits that *Shkedy* fails to disclose or suggest determining whether to invite a consumer to complete a survey related to a transaction. The Examiner relies upon *Pinsley* as allegedly disclosing such determining. However, *Pinsley* (and similarly the combination of *Shkedy* and *Pinsley*) fails to disclose or suggest determining, or instructions to cause a processor to determine, whether to invite a consumer to complete a survey related to the transaction “***based at least partially on at least one of the consumer information and the merchant information,***” as recited in claim 1.

At best, *Pinsley* discloses making an “offer to participate [in a survey] at the conclusion of [a] transaction.” (Col. 4, lines 9-11.) *Pinsley* does not, however, disclose determining whether to invite a customer to complete a survey ***based at least partially on consumer information or merchant information,*** or instructions to cause a processor to make such a determination, as recited in claim 1. Rather, *Pinsley* discloses offering a survey based on “random or statistically driven pseudo-random criteria.” (Col. 4, lines 11-13.) Indeed, *Pinsley* does not even disclose receiving consumer information or merchant information, much less making any determinations based on either of these types of information.

Claim 10 is not obvious in view of *Shkedy* and *Pinsley*

The combination of *Shkedy* and *Pinsley* fails to disclose or suggest each feature of independent claim 10. For example, the Examiner admits that *Shkedy* fails to disclose or suggest determining whether to collect survey information from a consumer in a transaction, and relies on *Pinsley* as allegedly disclosing “determining ... whether to collect survey information from a consumer.” (Office Action at 8.) The Examiner also asserts that *Shkedy* somehow discloses “determining, using historical consumer information” generally, pointing to the credit history maintained in the buyer database of that system. (Office Action at 8.)

The combination of *Shkedy* and *Pinsley* fails, however, to disclose or suggest “instructions to cause a processor to ... determine [or determining], ***using the historical consumer information***, whether to collect survey information from the consumer in the transaction,” as recited in claim 10. The Examiner has admitted that *Shkedy* fails to disclose or suggest determining whether to collect survey information at all. Although the Examiner has stated that *Shkedy* performs some type of determining using historical consumer information (pointing to the “credit history” disclosed in col. 10 of that document), Applicant respectfully submits that there is no discussion of making any determination using historical consumer information. To the contrary, the selection cited by the Examiner merely states that such data (e.g., “credit history” data) is maintained in a database.

Pinsley also fails to disclose or suggest determining, or instructions to cause a processor to determine, whether to collect such information by “***using the historical consumer information***,” as claimed. Rather, *Pinsley* describes making an offer to participate in a survey based on “random or statistically driven pseudo-random criteria.” (Col. 4, lines 11-13.) Indeed, there is no discussion of historical consumer information in *Pinsley* at all, much less instructions to cause a processor to make a determination using such information.

Claim 16 is not obvious in view of *Shkedy* and *Pinsley*

The combination of *Shkedy* and *Pinsley* fails to disclose or suggest each feature of independent claim 16. For example, *Shkedy* fails to disclose or suggest a processor configured “to determine whether to solicit survey information from the consumer to the transaction ***based at least partially on the transaction record***,” as recited in claim 16.

In the Office Action, the Examiner appears to have mistakenly asserted that *Shkedy* somehow discloses determining whether to solicit survey information from a consumer, despite admissions to the contrary with regard to claims 1 and 10.¹ *Pinsley* also does not disclose or suggest a processor configured to determine whether to solicit survey information ***based at least partially on the transaction record*** for reasons similar to those discussed above in connection with claim 1. Specifically, *Pinsley* discloses making an offer to participate in a survey at the

¹ This appears to be a mistake since the Examiner has cited a passage in *Pinsley* rather than *Shkedy* in support of this assertion.

conclusion of a transaction based on “random or statistically driven pseudo-random criteria,” and not based on any transaction record. (Col. 4, lines 11-13.)

There is no motivation to combine *Shkedy* and *Pinsley*

There is no motivation to combine the teachings of *Shkedy* and *Pinsley*. The Examiner argues that it would have been obvious to combine these references to collect “views ... to get a better idea of how to improve the processing of the transaction” (Office Action at 5) or to “determin[e] if the consumer would be worth keeping ...” (Office Action at 9, 11). These references, however, teach away from each other in such a manner that one skilled in the relevant art would be discouraged from combining them in the manner proposed in the Office Action.

For example, *Shkedy* is concerned solely with facilitating collective purchase agreements, and does not concern views of purchasers or surveys regarding those views. In fact, a specified object of *Shkedy* is to shield “characteristics and profile information on buyers or sellers ... from others such as marketing personnel ...” (Col. 3, lines 17-21.) Thus, because *Shkedy* emphasizes the importance of shielding buyer and seller information (i.e., the type of information that would be obtained by surveys) from marketing personnel (i.e., the people who would use survey results), one skilled in the art would be discouraged from attempting to obtain survey information (using the techniques of *Pinsley* or others), when implementing the teachings of *Shkedy*.

Pinsley, on the other hand, is almost exclusively concerned with conducting network-based surveys and, therefore, expressly teaches away from the object specified by *Shkedy* of shielding buyer and seller information from marketing personnel. Additionally, the opportunity to participate in a market survey, according to the teachings of *Pinsley*, is presented to a user if random criteria are met “at the conclusion of [each individual user’s] transaction.” (Col. 4, lines 9-11.) Because the system of *Shkedy* focuses on collective, or aggregate, transactions involving multiple users, one would be discouraged from attempting to combine the teachings of *Shkedy* and *Pinsley*.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests the withdrawal of the rejection of independent claims 1, 10, and 16. Additionally, for at least the

same reasons, Applicant respectfully requests withdrawal of the rejection of claims 2-9, 12-15, and 17-20, which depend therefrom.

Claim 11 is patentable under 35 U.S.C. § 103

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shkedy* in view of *Pinsley* and further in view of U.S. Patent No. 4,603,232 to Kurland et al. (hereinafter "*Kurland*"). Applicant respectfully traverses this rejection for the reasons set forth below.

Kurland is directed to a market survey collection and dissemination method that collects and disseminates market survey data electronically. *Kurland* appears to emphasize the rapid dissemination of market survey questionnaires electronically to multiple, remote survey participants.

The Examiner admits that *Shkedy* and *Pinsley* fail to disclose or suggest historical consumer information that "includes at least one of the number of invitations sent to the consumer and the number of surveys completed by the consumer," as recited in claim 11. The Examiner asserts that *Kurland* discloses this feature.

Applicant respectfully submits, however, that *Kurland* does not overcome the deficiencies of the combination of *Shkedy* and *Pinsley* with respect to independent claim 10, from which claim 11 depends.

Additionally, for reasons similar to those discussed above with respect to combining *Shkedy* and *Pinsley*, Applicant respectfully submits that there is no motivation to combine *Kurland* with *Shkedy*. For example, while an object of *Shkedy* is to shield "characteristics and profile information on buyers or sellers ... from others such as marketing personnel," *Kurland* teaches away from this practice by disseminating and using profile information (e.g., to allow surveys to be tailored to panelists having certain demographic profiles). (See Col. 6, lines 37-41.)

Accordingly for at least these reasons, Applicant respectfully requests the withdrawal of the rejection of claim 11.

Conclusion

All rejections having been addressed, Applicant respectfully submits that the present application is in condition for allowance, and earnestly solicits a Notice of Allowance, which is believed to be in order. Should the Examiner have any questions regarding this communication, or the application in general, he is invited to telephone the undersigned at 703-456-8108.

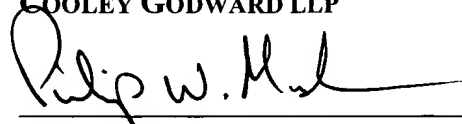
The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: 4/19/04

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